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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,104	01/20/2004	Sylvie Gauthier	6674-0038-1	4651

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EXAMINER	
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ART UNIT	PAPER NUMBER
1774	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/762,104	GAUTHIER ET AL.	
	Examiner	Art Unit	
	Tamra L. Dicus	1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 January 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) *10-20* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *1-22-07*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

All prior rejections are withdrawn.

Applicant's election of Group I, claims 1-9, in the reply filed on 03-09-06 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP §818.03(a)).

The requirement is still deemed proper and is therefore made FINAL.

Claim Objections

Claims 4 and 9 are objected to because of the following informalities: the language {"wherein the substrate is either"} is not an acceptable Markush group listing. One acceptable form of alternative expression, which is commonly referred to as a Markush group, recites members as being "selected from the group consisting of A, B and C." See Ex parte Markush, 1925 C.D. 126 (Comm'r Pat. 1925). Suitable language to include would be {"wherein the X are selected from the group consisting of". Appropriate correction is required.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-9 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-7 of copending Application No. 10/762,103 in view of Scher. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the copending application contain the subject matter that is narrower in scope than that in the instant claims, rendering them obvious over each other. Further a difference between using phenolic or melamine based formaldehyde impregnates are taught by Scher at 5:15-25 to be suitable for using in paper or cellulosic based papers, thus choosing one over the other would have been an obvious choice for creating a decorative laminate.

This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by McQuade, JR.

McQuade teaches in this order: press 18, Fig. 1 and associated text (overlayer), paper 20, Fig. 1 and associated text (decorative paper having leather surface is considered equivalent to a leather material), upper overlay 12, Fig. 1 and associated text (underlayer cellulosic sheet impregnated with melamine-formaldehyde resin), print sheet 10, Fig. 1 and associated text (cellulosic sheet impregnated with melamine-formaldehyde resin), and lower overlay 12' (backer layer cellulosic impregnated with the same aforementioned resin). Claims 1, 3, 5 are met.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-3, and 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scher in view of Schlup et al.

Scher teaches in this order: plate 26, Fig. 3A and associated text (overlayer), thermoplastic layer 24, Fig. 3A and associated text (decorative layer), overlay 20, Fig. 3A and associated text (cellulosic sheet impregnated with melamine-formaldehyde resin), embedment sheet 18, Fig. 3A and associated text (cellulosic sheet impregnated with melamine-formaldehyde resin), print sheet 16 (backer layer cellulosic impregnated with the same aforementioned resin),

and plate 12, Fig. 3A and associated text (second decorative layer of any dimensionally stable material). Claims 1, 3, 5-6, and 8 are addressed.

Scher teaches thermoplastic layer 24 being of any thermoplastic layer (5:55-65) and layer 26 of any dimensionally stable material.

Scher does not expressly disclose said layers are of a leather material nor a bonded leather (instant claim 1-2, 6-7), while using it in a laminated composite simulating leather.

Schlup teaches a leather/polymer composite material used in structural composite materials to improve hide/leather properties with impregnated polymer systems, such composite material improves several properties surrounding those effected by heat and pressure, namely toughness, machinability, compressibility and sealing where Schlup teaches the necessity of such an improvement in the hide and leather industries and laminated composites. See 1:10-20, 2:30-40, patented claims 1-15, Example 2, and Tables 1-2. Such description of this material is considered equivalent to Applicant's claimed leather or bonded leather materials.

It would have been obvious to one having ordinary skill in the art to have modified the composite of Scher to use the leather composite material of Schlup for the purpose of improving several properties surrounding those effected by heat and pressure, namely toughness, machinability, compressibility and sealing where the such an improvement in laminated composites is needed in the hide and leather industries as taught by Schlup (1:10-20, 2:30-40, patented claims 1-15, Example 2, and Tables 1-2.

Regarding the thickness recitation per instant claims 2 and 7, Schlup does not teach. However, it is submitted the optimal and/or claimed values of the respective material would have been obvious to the skilled artisan at the time the invention is made since it has long being held

that such discovery, such as an optimum value of the respective result effective variable involves only routine skill in the art. *In re boesch*, 617 F.2d 272,205 USPQ 215(CCPA 1980).

Claims 1-3, and 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scher in view of Schmoock.

Scher teaches in this order: plate 26, Fig. 3A and associated text (overlayer), thermoplastic layer 24, Fig. 3A and associated text (decorative layer), overlay 20, Fig. 3A and associated text (cellulosic sheet impregnated with melamine-formaldehyde resin), embedment sheet 18, Fig. 3A and associated text (cellulosic sheet impregnated with melamine-formaldehyde resin), print sheet 16 (backer layer cellulosic impregnated with the same aforementioned resin), and plate 12, Fig. 3A and associated text (second decorative layer of any dimensionally stable material). Claims 1, 3, 5-6, and 8 are addressed.

Scher teaches thermoplastic layer 24 being of any thermoplastic layer (5:55-65) and layer 26 of any dimensionally stable material.

Scher does not expressly disclose said layers are of a leather material nor a bonded leather (instant claim 1-2, 6-7), while using it in a laminated composite simulating leather.

Schmoock teaches a leather-containing composite material used in structural composite materials in application of heat and/or pressure as a low-cost alternative (Abstract, 3:1-40). Such description of this material is considered equivalent to Applicant's claimed leather or bonded leather materials.

It would have been obvious to one having ordinary skill in the art to have modified the composite of Scher to use the leather composite material of Schmoock for the purpose of

improving several properties surrounding those effected by heat and pressure where such an improvement in laminated composites is a low cost alternative to high-quality leathers as taught by Schmoock (3:1-45, Abstract).

Regarding the thickness recitation per instant claims 2 and 7, Schlup does not teach. However, it is submitted the optimal and/or claimed values of the respective material would have been obvious to the skilled artisan at the time the invention is made since it has long being held that such discovery, such as an optimum value of the respective result effective variable involves only routine skill in the art. *In re boesch*, 617 F.2d 272,205 USPQ 215(CCPA 1980).

Claims 4 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scher in view of Schlup or Schmoock, as applied to claims 1 and 6 above, and further in view of Takeuchi et al.

The combination is relied upon above.

The combination is silent to a substrate of materials listed in claims 4 and 9.

Takeuchi teaches a decorative composite where the substrate is of a variety of materials, including that of Scher, paper and cellulosic sheet materials, and also all those listed in claims 4 and 9 (5:10-61), thereby teaching equivalent materials used for the same supportive purpose as a substrate applied in composites.

It would have been obvious to one having ordinary skill in the art to have modified the composite of Scher and Schmoock to use plywood, medium density fiberboard, or particleboard because Takeuchi teaches they are equivalents to cellulosic sheets used as a substrate for composites (Takeuchi, 5:10-61, 12, Abstract).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is 571-272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Tamra L. Dicus
Examiner
Art Unit 1774

April 27, 2007

RENA DYE
SUPERVISORY PATENT EXAMINER
AU 1774